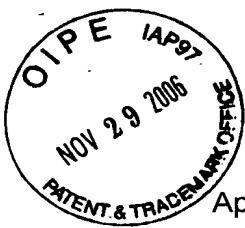


*Don*



500.40553CX1 / E6146-06CI

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): KAMO, et.al.  
Serial No.: 10/706,908  
Filed: November 14, 2003  
For: FUEL CELL, FUEL CELL GENERATOR, AND EQUIPMENT  
USING THE SAME  
Group: 1745  
Examiner: K. Walker  
Conf. No.: 7659

**RESPONSE TO RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

November 29, 2006

Sir:

This paper in response to the Office Action dated November 3, 2006, in  
connection with the above-identified application.

### **RESTRICTION REQUIREMENT - TRAVERSED**

A restriction requirement has been made for the reasons beginning on page 2 of the Detailed Action portion of the Office Action. Applicant respectfully traverses based upon the following ground(s).

### **NOT INDEPENDENT AND DISTINCT INVENTIONS**

As traversal, Applicant notes that 35 USC '121, the basis for a restriction and election of species requirement, provides for a restriction only if two or more independent and distinct inventions are claimed in one application. While '802.01 of the Manual of Patent Examining Procedure indicates that restriction and/or election of species may be permissible between independent or distinct inventions, such section of the Manual of Patent Examining Procedure is clearly erroneous in view of the plain and unambiguous language of 35 USC '121.

In this connection, the above-noted section of the Manual of Patent Examining Procedure defines the term "independent" as meaning there is no disclosed relationship between the two or more subjects disclosed that is, they are unconnected in design, operation or effect. It is respectfully submitted that a contention cannot validly be made that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention have no disclosed relationship, for if such is the case, such contentions are clearly without merit as a review of the instant specification and the claimed subject matter reveals. More particularly, to show that Applicant's claims are related, Applicant respectfully submits that the Office Action comments admit that the various groups and/or species are related.

With further regard to the erroneous restriction/election position presented in the Manual of Patent Examining Procedure (i.e., teaching restriction/election for "independent or distinct inventions", instead of the unambiguous "independent and distinct inventions" statutory language), as pointed out by Mr. McKelvey in the concurring opinion in Ex parte Hartmann, 186 USPQ 366 (Bd. App. 1974), relying upon the Decision of Ex parte Schwarze, 151 USPQ 426 (Bd. App. 1966) the Manual of Patent Examining Procedure merely provides guidelines for Examiners in the Patent Office and it does not replace, and is subservient to, applicable statutes, Rules of Practice, and prior decisions. Thus, it would appear that by virtue of the plain and unambiguous language of 35 USC '121, the statute only permits an election of species requirement between two or more independent and distinct inventions (not independent or distinct inventions) in spite of the circumlocutory argumentation of '802.01 of the Manual of Patent Examining Procedure.

Furthermore, in view of the interrelationship of the inventions designated in the Office Action, and in view of the fact that each of the designated inventions are, in essence, based upon the same basic inventive concept, Applicant respectfully submits that the designated inventions are not independent and distinct to the extent required by 35 USC '121 to support a restriction requirement. Further, Applicant respectfully submits that any differences should not be considered as rendering the respective embodiments independent and distinct to the extent required by 35 USC '121.

In summary, a review of the Office Action reveals that the Office Action has failed to clearly indicate how the subject matter recited in the respective groups of

claims represents both independent and distinct inventions are required by 35 USC '121.

### **IMPROPER ELECTION REQUIREMENT- CLAIMS ARE NEVER SPECIES**

The Office Action Election Requirement attempts to list different groups of claims as differing species, without further elaboration. Such represents an improper Election Requirement. More particularly, as stated in MPEP 806.04(e), "Claims are definitions of inventions. Claims are never species." Accordingly, Applicant respectfully traverses the Requirement, and respectfully submits that the election of species requirement should be withdrawn and all claims considered and allowed.

### **PROVISIONAL ELECTION**

In order to comply with the requirement, Applicant provisionally elects, with traverse, for prosecution on the merits, Group I, including at least claims 13, 14 and 16-21 and Species I-a.

### **NO ADMISSION - RESTRICTION/ELECTION**

Applicant submits that the instant response (including the comments submitted and the provisional election) is not an admission on the record that the respective species are separately distinct species and/or obvious variants.

**CONTINUATION(S)/DIVISIONAL(S) FOR NON-ELECTED SUBJECT MATTER**

Despite any traversal set forth in other parts of this paper regarding any Restriction/Election, one or more related (e.g., continuation/divisional) applications may be filed to pursue subject matter not elected in the present application.

Applicant submits that any filing of continuation(s)/divisional(s) should not be taken as any prejudice, admission or disclaimer that the Restriction/Election is correct, but instead, is merely use of separate applications to move the other subject matter through the patenting process.

**CONTINUATION(S)/DIVISIONAL(S) - DOUBLE PATENTING PROHIBITED**

Regarding any related continuation/divisional application(s) filed to pursue subject matter identical to or consonant with Restriction/Election subject matter not elected in the present application, it is respectfully submitted that the third sentence of 35 U.S.C. 121 and MPEP 804.01 prohibit any double-patenting rejection between this and the related continuation/divisional applications.

**EXAMINER INVITED TO TELEPHONE**

The Examiner is herein invited to telephone the undersigned attorneys at the local Washington, D.C. area telephone number of 703/312-6600 for discussing any Examiner's Amendments or other suggested actions for accelerating prosecution and moving the present application to allowance.

### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or any present amendment or cancellation of claims (all made without prejudice or disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, i.e., Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is now in condition for allowance.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR '1.136. Authorization is herein given to charge any shortage in the fees,

including extension of time fees and excess claim fees, to Deposit Account No. 01-2135 (Case No. 500.40553CX1) and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Paul J. Skwierawski  
Registration No. 32,173

PJS/slk  
(703) 312-6600